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1 UNITED STATES PATENT AND TRADEMARK OFFICE

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4 BEFORE THE BOARD OF PATENT APPEALS
5 AND INTERFERENCES
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8 *Ex parte* WILLIAM H. WHITTED
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11 Appeal 2008-4090
12 Application 10/677,107
13 Technology Center 3600
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16 Decided: October 30, 2008
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19 *Before* WILLIAM F. PATE, III, JENNIFER D. BAHR and DANIEL S.
20 SONG, *Administrative Patent Judges*.

21
22 SONG, *Administrative Patent Judge*.
23

24 DECISION ON APPEAL

25
26 STATEMENT OF THE CASE

27 The Appellant appeals under 35 U.S.C. § 134 (2002) from a Final
28 Rejection of claims 1-14. We have jurisdiction under 35 U.S.C. § 6(b)
29 (2002).

1 The Appellant claims a frame structure that is configured to receive a
2 plurality of rack mount electronics modules, the rack including a rail with an
3 angled face for strengthening the rack.

4 Representative independent claim 1 reads as follows:

- 5 1. A frame structure for a rack mount computer system
6 having a plurality of rack mount electronics modules,
7 comprising:
8 four corner supports, each corresponding pair of corner
9 supports defining a front side, a rear side, a first side, and a
10 second side of the frame structure therebetween; and
11 a first side wall disposed on the first side of the frame
12 structure, the first side wall including:
13 at least two first rails extending between the
14 corresponding pair of the corner supports, the frame structure
15 being configured to receive the plurality of rack mount
16 electronics modules such that each module generally extends
17 between the front and rear sides, between the first and second
18 sides, and are generally parallel to the first rails and generally
19 orthogonal to the corner supports, at least one of the first rails
20 being an angled first rail having an angled face with a first
21 exterior edge and a first interior edge recessed from the first
22 side relative to the first exterior edge, the first angled face
23 further having two first end edges each extending between the
24 first exterior edge and the first interior edge, the two first end
25 edges being at an angle less than 90° relative to the first side
26 and being substantially attached to the corresponding pair of the
27 corner supports.

28
29 Independent claim 8 is also directed to a rack for a rack mount
30 computer system.

31 The prior art relied upon by the Examiner in rejecting the claims is:

32 Anderson US 6,605,777 B1 Aug. 12, 2003

The Examiner rejected claims 1-14 under 35 U.S.C. § 102(a) as anticipated by Anderson.

We AFFIRM.

ISSUE

The sole issue raised in the present appeal is whether the Appellant has shown that the Examiner erred in rejecting the claims as anticipated by Anderson.

PRINCIPLES OF LAW

“A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference.” *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631 (Fed. Cir. 1987). Analysis of whether a claim is patentable over the prior art under 35 U.S.C. § 102 begins with a determination of the scope of the claim.

We determine the scope of the claims in patent applications not solely on the basis of the claim language, but upon giving claims their broadest reasonable construction in light of the specification as it would be interpreted by one of ordinary skill in the art. *In re Prater*, 415 F.2d 1393, 1395-96 (CCPA 1969). “Absent claim language carrying a narrow meaning, the PTO should only limit the claim based on the specification or prosecution history when those sources expressly disclaim the broader definition.” *In re Bigio*, 381 F.3d 1320, 1325 (Fed Cir. 2004). Furthermore,

1 giving broad construction to claim terms is not unreasonable during
2 examination because the applicant can amend the claims. *See In re Am.*
3 *Acad. of Sci. Tech. Ctr.*, 367 F3d 1359, 1364 (Fed. Cir. 2004). The properly
4 interpreted claim must then be compared with the prior art.

6 ANALYSIS

7 In the Appeal Brief, the Appellant argues all of the rejected claims
8 together as a group except for dependent claim 12 which is argued
9 separately. Thus, we select representative claim 1 to decide the appeal of the
10 rejection of claims 1-11, 13 and 14, these claims standing or falling together.
11 *See* 37 C.F.R. § 41.37(c)(1)(vii). Claim 12 is addressed separately *infra*.

13 Claims 1-11, 13 and 14

14 The Examiner states that the rack mount electronics modules are not
15 positively claimed, but instead, are only functionally recited with no definite
16 structure (Ans. 4). Thus, the Examiner concludes that Anderson describes
17 the invention of claim 1 because the frame of Anderson is capable of
18 supporting rack mount electronics modules (Ans. 4).

19 In the Appeal Brief, the Appellant initially argues that even though
20 rack mount electronic modules are not positively recited, claim 1 specifically
21 recites a frame structure which is “configured to receive the plurality of rack
22 mount electronics modules,” and thus, electronic modules structurally define
23 the claimed frame structure (App. Br. 4). The Appellant also argues that in
24 the frame of Anderson, each chamfered support member 28 is generally

1 *orthogonal* to the electronics modules to be received therein (App. Br. 5). In
2 other words, the Appellant argues that the frame of Anderson does not
3 describe a frame structure that is configured to receive electronics modules
4 so that each electronics module is “generally parallel to the first rails,” the
5 first rails having the angled faces also recited in claim 1.

6 As a preliminary matter, we do not disagree with the Appellant’s
7 contention that “configured to receive the plurality of rack mount electronics
8 modules” further defines the claimed rack. In fact, we do not understand the
9 Examiner’s position to be that the reference to electronic modules in claim 1
10 does not limit claim 1. Instead, the Examiner’s position is that claim 1 is
11 broadly worded to merely require that the frame of Anderson be capable of
12 receiving rack mount electronics modules of undefined size, shape or
13 orientation, because the electronics modules are recited functionally without
14 corresponding structure (Ans. 4). As discussed in detail *infra*, we do not
15 find error in the Examiner’s findings and conclusion.

16 Turning to the language of the claim, we agree with the Examiner’s
17 finding (Ans. 4) that claim 1 does not positively recite the rack mount
18 electronics modules. In addition, we find that claim 1 is directed to “[a]
19 frame structure.” Recitation to the rack mount computer system is made
20 only within the preamble of claim 1 and is phrased as an intended use for the
21 claimed frame structure. Thus, the limitation of claim 1 in dispute merely
22 requires that the frame of Anderson be configured so that it can “receive” the
23 plurality of rack mount electronics modules such that they are “generally
24 parallel to the first rails.”

1 The term “receive” recited in claim 1 does not appear to be used in the
2 Specification for describing any interconnection between the claimed frame
3 structure and the rack mount electronics modules. Instead, the Appellant
4 uses the terms “mount,” “secure,” and “support,” as well as variations
5 thereof, to describe such interconnection in the Specification.¹ In the Appeal
6 Brief, the Appellant refers to the portion of the Specification which sets forth
7 various examples of suitable structures (e.g., pairs of opposing shelf
8 supports, slide assemblies) for supporting the electronics modules to suggest
9 that such structures are required in order for the rack of Anderson to be
10 “configured to receive” electronics modules (App. Br. 4). However, the
11 Appellant’s argument fails because claim 1 does not recite any structural
12 limitations corresponding to any of the example suitable support structures.
13 *See In re Self*, 671 F.2d 1344, 1348 (CCPA 1982). Moreover, we
14 understand the cited portion of the Specification as merely describing
15 examples of suitable structures that can be used in conjunction with the
16 claimed frame structure for actually supporting or mounting the electronics
17 modules, not that the frame structure requires the unrecited suitable
18 structures.² Thus, the Specification does not preclude broad construction of

¹ See Specification: page 3, lines 6, 7 and 17-19; page 7, lines 12-15; page 8, lines 1-3.

² Specification, page 7, lines 12-15 states: “[t]he support columns 14 and/or side walls 22 [the] may provide surfaces on which to mount pairs of opposing shelf supports, slide assemblies, or any other suitable support structure (not shown) to support the stack of electronics modules 20.”

1 the claim limitation “configured to receive”. See *In re Prater*, 415 F.2d at
2 1395-96; *In re Am. Acad. of Sci. Tech. Ctr.*, 367 F.3d at 1364.

3 Moreover, as stated by the Examiner, the limitation reciting parallel
4 orientation of the rack mount electronics modules to the first rails is without
5 substance because the electronics modules are recited in claim 1 functionally
6 and without any corresponding structure (Ans. 4). In particular, the claim
7 language does not recite any structural limitations with respect to the rack
8 mount electronic modules which can serve to define, and thereby limit, what
9 constitutes the recited the parallel orientation relative to the first rails. We
10 understand “rack mount electronics modules” to be three-dimensional, box-
11 shaped devices.³ When such electronics modules are “received” in the
12 frame of Anderson, at least one side thereof would be “generally parallel” to
13 the first rails (i.e., chamfered support member 28) as recited in claim 1,
14 regardless of whether the frame is upright as described in Anderson, or laid
15 on its side as applied by the Examiner in the annotated Figure 1 provided in
16 the Examiner’s Answer.

17 Therefore, in view of the above, we conclude that the rack of
18 Anderson satisfies the limitation “the frame structure being configured to
19 receive the plurality of rack mount electronics modules such that each
20 module . . . [is] generally parallel to the first rails” as recited in independent

³ Specification, page 3, lines 6 and 7 states: “[t]ypically the electronics modules mounted into most electronics racks are in the form of 1U to 8U boxes.”

1 claim 1. Hence, the Appellant has not shown that the Examiner erred in
2 rejecting claims 1-11, 13 and 14 as anticipated by Anderson.

3 Claim 12

4 The Appellant contends that the cross strut members 30 of Anderson
5 extend between the chamfered support members 28 instead of extending
6 between the corner posts (i.e., corner supports) as specifically recited in
7 claim 12 (App. Br. 5). In addition, the Appellant contends that if the top and
8 bottom panel assemblies 22 and 24 are read as corresponding to the corner
9 posts, the cross strut members 30 are parallel to the corner posts instead of
10 extending therebetween as recited in claim 12 (App. Br. 5).

11 However, the Examiner responds that the Appellant has
12 misinterpreted the rejection and points out that the edge bar of element 22 or
13 24 as shown in the annotated Figure 1 of Anderson, not element 30, is read
14 as corresponding to the recited cross bar (Ans. 4). Indeed, as stated by the
15 Examiner, the edge bar of element 22 or 24 extends between two corner
16 posts (i.e., corner supports). Therefore, we find that the Appellant has failed
17 to show that the Examiner erred in rejecting claim 12 as anticipated by
18 Anderson as well.

19
20 CONCLUSION

21 On the record before us, Appellant has not shown that the Examiner
22 erred in rejecting claims 1-14.

ORDER

The Examiner's rejection of claims 1-14 is AFFIRMED.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a). *See* 37 C.F.R. § 1.136(a)(1)(iv) (2007).

AFFIRMED

BAHR, *Administrative Patent Judge*, concurring:

While I join my colleague in the opinion in support of the affirmance of the Examiner's decision rejecting claims 1-14, I offer the following additional comments in response to the opinion of our dissenting colleague.

I begin by pointing out the well established principle that features not appearing in the claims cannot be relied upon for patentability. *In re Self*, 671 F.2d 1344, 1348 (CCPA 1982). As stated by our reviewing court in *In re Hiniker Co.*, 150 F.3d 1362, 1369 (Fed. Cir. 1998), "the name of the game is the claim." When construing claim terminology in the United States Patent and Trademark Office, claims are to be given their broadest

1 reasonable interpretation consistent with the specification, reading claim
2 language in light of the specification as it would be interpreted by one of
3 ordinary skill in the art. *In re Am. Acad. of Sci. Tech. Ctr.*, 367 F.3d 1359,
4 1364 (Fed. Cir. 2004). We must be careful not to read a particular
5 embodiment appearing in the written description into the claim if the claim
6 language is broader than the embodiment. *See Superguide Corp. v. DirecTV*
7 *Enterprises, Inc.*, 358 F.3d 870, 875 (Fed. Cir. 2004) (“Though
8 understanding the claim language may be aided by the explanations
9 contained in the written description, it is important not to import into a claim
10 limitations that are not a part of the claim. For example, a particular
11 embodiment appearing in the written description may not be read into a
12 claim when the claim language is broader than the embodiment.”) The
13 challenge is to interpret claims in view of the specification without
14 unnecessarily importing limitations from the specification into the claims.
15 *See E-Pass Techs., Inc. v. 3Com Corp.*, 343 F.3d 1364, 1369 (Fed. Cir.
16 2003).

17 Our dissenting colleague implies an obligation on our part to explain
18 how Anderson discloses the “argued feature” of “the orthogonal direction of
19 the chamfered support members and the weldments thereon.” My first
20 difficulty with this imputed obligation is that I find no such argument in the
21 Appellant’s Appeal Brief. In particular, the portions of Appellant’s Appeal
22 Brief cited in the dissent as making this argument make no reference
23 whatsoever to weldments, or any other structures, on the chamfered support
24 members. Additionally, and perhaps more importantly, claim 1 contains no

1 reference to, much less a positive recitation of, weldments, or any other
2 structures, on the chamfered support members, that is, the first rails recited
3 in claim 1. The dissenting opinion does not explicitly point out where, if at
4 all, such limitation is found in claim 1.

5 The dissenting opinion appears to accord great significance to the
6 terminology “rack mount.” While I agree with my dissenting colleague that
7 claim 1 is directed to a frame structure “for a rack mount computer system,”
8 the dissenting opinion does not convince me that Anderson’s earthquake-
9 resistant electronic equipment frame is not a frame structure for a rack
10 mount computer system, whether in the orientation illustrated in Anderson’s
11 Figure 1 or in an orientation rotated 90 degrees from that orientation, as
12 clearly proposed by the Examiner (Ans. 3) in the rejection.

13 Based on the Appellant’s discussion of rack-mounted systems
14 (Specification ¶ 2), I understand rack-mounted systems to be systems in
15 which a number of removable electronics modules are positioned and
16 stacked relative to each other in a shelf-like manner within a frame or rack
17 and which allow several of the electronics modules to be arranged in a
18 vertical orientation for efficient use of space. I find no requirement in this
19 discussion that a rack mount system comprise a frame structure that has a
20 height dimension larger than its width or depth dimension. Nor has the
21 Appellant specifically argued, much less shown, that the terminology “rack
22 mount computer system” has an accepted meaning within the art that
23 requires a frame structure having a height dimension larger than its width or
24 depth dimension.

PATE, III, *Administrative Patent Judge*

I respectfully dissent.

I would reverse the § 102 rejection of independent claims 1 and 8, and the claims that depend therefrom, as lacking novelty over Anderson.

Appellant's brief states:

In contrast, Anderson discloses side assemblies 26 that extend between a top and bottom panel assembly 22, 24. Each side assembly 26 includes two corner support channels each in the form of a corrugated and chamfered support member 28 and a series of cross strut members 30 anchored there between. (Col. 3, lines 39-44). As shown in FIG. 14b, the chamfered support member 28 may be angled inward from the top and bottom panel assemblies 22, 24.

However, each chamfered support member 28 are such that they are generally orthogonal to the electronics modules to be received therein.

Reversal of the rejection of independent claims 1 and 8 as well as claims 2-7 and 9-13 dependent variously therefrom is requested.

Brief 5: 1-10.

In general, I take this as an argument that Anderson is not anticipatory of the structure of claim 1, particularly with regard to the orthogonal direction

1 of the chamfered support members and the weldments thereon. The
2 majority opinion does not contain an explanation of if or how Anderson
3 discloses this argued feature. If the majority is relying on the Anderson
4 reference as interpreted by the Examiner, with the rack disclosed therein
5 turned on its side, it would seem incumbent on the majority's part to so state
6 for the record.

7 However, my main area of disagreement is one of claim construction. I
8 am of the view that a proper claim construction calls for the structure of
9 claim 1 to be a frame for a "rack mount" for electronic modules rather than a
10 frame per se. This is so because the rack mount recitation in line 1 of the
11 preamble is given life and meaning by the recitation of the rack mount
12 structure in line 12 (as the claim is reproduced in the majority opinion). This
13 is even more the case since the rack mount is recited as having a particular
14 function in line 12, that of housing electronic modules. Appellant could not
15 have made it any clearer that the claimed article is a frame for an electronic
16 rack mount. Therefore, the claim is not directed to merely a frame that can
17 be considered in any orientation but to a rack mount standing vertically and
18 available to accept electronic modules in the customary manner of electronic
19 mounting systems.

20 It may be argued that the frame is capable of receiving electronic
21 components when the frame is on its side as argued by the Examiner. I view
22 this argument to be speculative, not supported by any evidence, and,
23 ultimately, unreasonable. One of ordinary skill in the electronic or computer

arts understand what electronic rack mounts are and how they are designed
to be disposed to hold electronic components.

I would reverse the rejection under § 102.

LV

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